

U.S.S.N. 09/373,403

Arathoon et al.

Response to Office Action of February 7,2007, and Request for Reconsideration

REMARKS

Claims 30-36, 38, 40-43, 45, 46-51 and 53-55 are pending in this application. Claims 30, 33, 34, 38, 48 and 50 are amended; claims 37 is canceled. The amendments are of a formal nature and do not add new matter. All amendments and cancellations are made without prejudice or disclaimer. Applicants reserve the right to pursue canceled or amended subject matter in this or related patent applications.

WITHDRAWAL OF REJECTIONS/OBJECTIONS

Applicants acknowledge withdrawal of the provisional rejection of claims 30-43, 45-51 and 53-55 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 88-109 of co-pending Application No. 09/863,693 due to the abandonment of 09/863,693.

Applicants acknowledge withdrawal of the rejection of claim 51 under 35 U.S.C. 112, second paragraph, as being indefinite.

Applicants acknowledge withdrawal of the rejection of claims 30-42 under 35 U.S.C. 112, first paragraph, on the grounds that the Applicants were not in possession of the claimed inventions at the time of filing.

Applicants acknowledge withdrawal of the objection to claim 37 under 37 CFR 1.75(c) as being of improper dependent form for failing further limit the claimed subject matter.

Applicants acknowledge withdrawal of the rejection of claims 30-43, 45-49, 50, 51 and 53-55 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

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DOUBLE PATENTING

Applicants acknowledge the provisional rejection of claims 30-38, 40-43, 45-51 and 53-55 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 47-63 of co-pending Application No. 09/520,130. Applicants request that the Examiner hold this rejection in abeyance until notice of allowable subject matter.

Applicants acknowledge the provisional rejection of claims 30-38, 40-43, 45-51 and 53-55 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 45-82 of co-pending Application No. 10/143,437, now U.S. Patent No. 7,183,076. Applicants request that the Examiner hold this rejection in abeyance until notice of allowable subject matter.

Applicants also wish to bring to the Examiner's attention the following currently co-pending patent applications: U.S. application serial no. 11/537,195, U.S. application serial no. U.S. application serial no. 11/608,673, U.S. application serial no. 11/536,951, and U.S. application serial no. 11/536,439. Applicants request that the Examiner hold any further double-patenting rejections in abeyance until notice of allowable subject matter.

RESPONSE TO ARGUMENT

Applicants thank the Examiner for considering the response filed on November 20, 2006. The Examiner rejected claims 30, 40, 41, 50 and 51 under 35 U.S.C. 102(b) as allegedly being anticipated by Nissim (Nissim, A. et al., The EMBO Journal, 13(3): 692-698, 1994) as evidenced by Merchant (Merchant, A.M. et al, Nature Biotechnology, 16: 677-681, 1998). The Examiner stated that Nissim teaches methods for expressing scFv fragments in E. coli from a phage library, and that Merchant teaches that the phage library of Nissim has extensive H chain repertoires but a unique L chain sequence. The Examiner concluded that each antibody fragment derived from Nissim's phage library has the same L chain. The Examiner further stated that Nissim also teaches the making of "polyclonal" supernatants via multimerization occurring in the

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supernatants, especially when the supernatant is concentrated. The Examiner argued that Nissim teaches that the multimerization appears to occur through the binding of an L chain region from one chain binding to an H chain region from another chain. Therefore, the Examiner concluded, Nissim allegedly teaches the claimed methods of producing multispecific antibodies. Further, the Examiner stated, Nissim also teaches the isolated host cells of claim 41, because Nissim teaches how to make the *E. coli* that produce the scFv fragments.

Applicants respectfully submit that the rejection no longer applies to the claims as amended. The Examiner withdrew the rejection to claim 43 due to the active claim limitation of selecting a nucleic acid. However, the Examiner maintained the rejection to claims 30 and 50 as they do not characterize the structure of the multimerization domain, and the Examiner referenced the structure of diabodies. Without acquiescing to the rejection, or the Examiner's reasoning underlying the rejection, claims 30 and 50 are amended herein to further characterize the multimerization domain, *inter alia*, as comprising a heavy chain constant region. Applicants submit that the amended claims are further distinguished from diabodies. Applicants also submit that the claims as amended are not anticipated by Nissim under 35 U.S.C. 102(b).

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Conclusion

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 30-36, 38, 40-43, 45, 46, 48-51 and 53-55 at an early date is solicited. No fee is believed due with this response. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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SD 871693 v4 (39766.0215)